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OFFICE OF PETITIONS
DEPUTY A/C PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Klaus Florian Schuegraf et al.
Title: SELECTIVE SPACER TO PREVENT METAL OXIDE FORMATION DURING POLYCIDIC REOXIDATION
Docket No.: 303.278US1
Filed: July 30, 1997
Examiner: O Nadav
Serial No.: 08/902,809
Due Date: January 14, 2000
Group Art Unit: 2811

Assistant Commissioner for Patents
Washington, D.C. 20231

We are transmitting herewith the following attached items (as indicated with an "X"):

- X A return postcard.
- X A Response (8 Pages).

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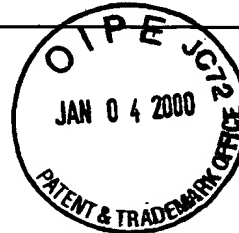
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RESPONSE



OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Assistant Commissioner for Patents
Washington, D.C. 20231

In response to the Office Action mailed October 14, 1999, the applicant respectfully requests reconsideration of the above-identified application in view of the following remarks. Claims 23-31 and 36-44 are pending in the application, and are rejected. The pending claims 23-31 and 36-44 have not been amended.

Drawings

The Examiner objected to the drawings. The applicant respectfully traverses. As will be demonstrated below, an oxide layer 215 is shown in each of Figures 2A-2D.

Specification

The Examiner objected to the amendment filed on July 27, 1999, under 35 USC § 132 on the grounds that it introduced new matter. The applicant respectfully traverses. The amendment to the specification filed on July 27, 1999, replacing the term "active area 215" on pages 4 and 5 with the term "--oxide layer 215--", does not introduce new matter, as will be demonstrated in the following remarks.

Applicable Case Law

The Federal Circuit has addressed the sufficiency of a disclosure in *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991). The written description requirement of 35 USC § 112 comes into play under several circumstances, including a "new matter" rejection under 35 USC § 132. *Vas-Cath*, 19 USPQ2d at 1114. The court then defined the inquiry for the requirement with the following passage: